

O-096-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2365034
BY MARSHALLS MONO LIMITED
TO REGISTER THE TRADE MARK:**

CAMPUS

IN CLASSES 6, 11 AND 20

AND

**THE OPPOSITION THERETO
UNDER NO 93264
BY
LAMMHULTS MÖBEL AB**

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**In the matter of application no 2365034
by Marshalls Mono Limited
to register the trade mark:
CAMPUS
in classes 6, 11 and 20
and the opposition thereto
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by Lammhults Möbel AB**

BACKGROUND

1) On 4 June 2004 Woodhouse UK plc applied to register the trade mark **CAMPUS** (the trade mark). The application has since been assigned to Marshalls Mono Limited, which I will refer to as Marshalls. The application was published for opposition purposes in the *Trade Marks Journal* on 10 December 2004. The application is in three classes. However, only certain of the goods in the class 20 specification are the subject of this opposition, namely:

street furniture, namely benches, seats and tables; parts and fittings for all the aforesaid goods; none being for domestic or household use.

2) On 10 March 2005 Lammhults Möbel AB, which I will refer to as Lammhults, filed a notice of opposition to the application. Lammhults is the owner of Community trade mark registration no 696492 for the trade mark **CAMPUS**. The application for registration was made on 5 December 1997 and the registration process was completed on 19 March 1999. It is registered for the following goods:

furniture, including chairs and tables.

The above goods are in class 20 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Lammhults states that the respective trade marks are identical. It claims that the goods of its registration are identical to

street furniture, namely benches, seats and tables; none being for domestic or household use.

Consequently, registration of the trade mark in respect of such goods would be contrary to section 5(1) of the Trade Marks Act 1994 (the Act). In the event that the above goods are not considered to be identical they are similar, as are parts of fittings for the goods, and consequently there is a likelihood of confusion and registration of the trade mark would be contrary to section 5(2)(a) of the Act.

3) Lammhults requests the deletion of the words *benches, seats and tables* from the specification and an award of costs.

4) Lammhults claims that it has used its trade mark in relation to chairs and tables.

5) Marshalls filed a counterstatement. It denies that the respective goods are either identical or similar. Marshalls did not accept the claim of use made by Lammhults and requested proof of use of the trade mark. It requests the rejection of the opposition and an award of costs.

6) Both sides filed evidence.

7) A hearing was held on 22 March 2007. Marshalls was represented by Mr Saunders of counsel, instructed by Withers & Rogers. Lammhults was represented by Mr Brandreth of counsel, instructed by Saunders & Dolleymore.

EVIDENCE

Evidence of Lammhults

Witness statement of Birgitta Andersson

8) Witness statement of Birgitta Andersson. Ms Andersson's statement deals with a request from Marshalls for consent to register the trade mark. She states that this request was refused.

Witness statement of Claes Brechensbauer.

9) Mr Brechensbauer is the president of Lammhults. Mr Brechensbauer also comments upon the refusal to give consent for the registration of the trade mark.

10) Mr Brechensbauer states that the trade mark CAMPUS has been used in relation to chairs and tables in the United Kingdom since 1993. Mr Brechensbauer states that CAMPUS products have been responsible for the following proportion of sales of Lammhults products:

	CAMPUS as a percentage of total sales
1999	73.6
2000	31.1
2001	22.4
2002	38.1
2003	20.4
2004	11.8
2005	14.6

Mr Brechensbauer gives the following turnover figures:

	£
1997	73,435
1998	66,997
1999	261,936
2000	103,320
2001	111,015
2002	173,542
2003	61,400
2004	72,010

The above figures are based upon ex-factory prices.

11) Mr Brechensbauer gives the following figures in relation to promotion of the Lammhults business in the United Kingdom:

	SEK	Approximate £ sterling equivalent rate of exchange of 1 SEK = £ 0.07
2001	600,830	44,140
2002	33,662	2,475
2003	77,838	5,720
2004	48,803	8,585

The trade mark has been promoted by means of:

- an advertisement in *Blueprint 1997*;
- exhibiting at '100% Design' exhibition annually from 1998 to 2002 at Earls Court in London;
- placing advertisements in *Architectural Review* from 1997 to 2003.

12) Mr Brechensbauer states that United Kingdom customers for CAMPUS tables and chairs have included the following:

Grantown Museum, Grantown, Scotland;
Milton Keynes Gallery, Milton Keynes;
The Scotch Whisky Heritage Centre, Edinburgh;
British Airways;
The Millennium Stadium, Cardiff;
Earls Court, London;
Scottish Equitable plc.

13) Exhibited at LM2 are various pricelists and catalogues showing use of the trade mark CAMPUS. A Lammhults retail price list from 1992 shows CAMPUS chairs and armchairs; the products are linkable and stackable. The armchair can be supplied with a

writing tablet. A Lammhults retail price list from 1994 shows CAMPUS chairs, armchairs and tables; again the chairs are linkable and stackable. Accessories for the chairs include trolleys, storage boxes, writing tablets and hymn racks. A table shown can be used as a stand-alone piece of furniture or to form various shapes, the table being linkable and being in modular form. A catalogue for CAMPUS by Lammhults is exhibited, this is in Swedish, a translation is provided. Pictures of CAMPUS chairs and tables are also shown in this exhibit; these show the furniture being used in restaurants, libraries, cafés, offices and at a university. A further list included in this exhibit shows various CAMPUS tables including a café table. Copies of pages from a book entitled *The Collected Works of Lammhults* is exhibited, this includes references to CAMPUS chairs. Finally, the exhibit includes pages which show a conference table, a chair with an accessory to hold a laptop, a café table, a table, a chair and an armchair. Exhibited at LM3 are various invoices:

Mooch at Living, Birmingham - 31/01/05 - 231 CAMPUS chairs;
Pizza Express, Hitchin - 23/09/04- 150 CAMPUS chairs;
Pizza Express, Byward Street, London - 30/04/03 - 165 CAMPUS chairs;
Queen Margaret's School in York - 28/02/02 - 286 CAMPUS chairs with 286 CAMPUS linking devices;
Pizza Express, Haymarket, London - 17/12/01 - 136 CAMPUS chairs;
Synergi Ltd, Barking, Essex - 28/06/01 - 104 CAMPUS chairs and 16 CAMPUS barstools;
Pizza Express, Exmouth Street, London - 26/10/2000 - 70 CAMPUS chairs;
Conran Shop, London - 31/03/00 - 150 CAMPUS chairs, 2 CAMPUS trolleys and 150 CAMPUS linking devices;
Conran Shop, London - 31/03/00 – 10 CAMPUS tables of 3 different types, all with attachments for loose linking devices, 2 additional CAMPUS tops with loose attachment;
Millennium Stadium, Cardiff - 11/08/99 - 699 CAMPUS chairs;
Dovetail Enterprises, Dundee - 24/03/99 - 20 CAMPUS chairs;
Ralph Capper Interiors Ltd, Manchester - 21/11/95 – 40 CAMPUS chairs;
Ralph Capper Interiors Ltd, Manchester - 31/07/96 - 3 CAMPUS tables;
Nottingham Castle Museum - 08/11/96 - 33 CAMPUS chairs with 33 CAMPUS linking devices;
Central Hall Trust, London - 30/07/96 - 17 CAMPUS chairs, 6 CAMPUS tables and 6 CAMPUS linking devices for said tables;
Well Golshall & Manges - 25/03/96 - 16 CAMPUS chairs.

14) Shown at LM4 is a list of awards that CAMPUS chairs and tables have received between 1992 and 1995; five awards have been made, three emanating from Germany, one from Sweden and one from the United States of America.

Evidence of Marshalls

Witness statement by Michael John Wintermeyer.

15) Mr Wintermeyer is the marketing manager for the Woodhouse trading division of Marshalls. Mr Wintermeyer states that Woodhouse is one of the leading designers and manufacturers of contemporary exterior lighting and street furniture in the United Kingdom. On 14 May 2004 Woodhouse UK Plc was purchased by Marshalls plc.

16) Mr Wintermeyer states that the trade mark has been used throughout the United Kingdom. He lists projects with which Woodhouse has been involved but does not state if CAMPUS products have been used in the projects. Mr Wintermeyer states that CAMPUS products have been sold to various companies within the United Kingdom, with sales since 31 October 2005 totalling £60,323. He states that despite the products being available there have been no incidents of confusion.

17) Mr Wintermeyer states that the range of street furniture sold under the CAMPUS brand includes wayfinding, street furniture and lighting products. He states the litterbins, seating, signage, bollards, cycle stands and shelters available under the CAMPUS brand are all made from sustainable materials. He states that the lighting uses small-format ceramic metal halide technology.

18) Mr Wintermeyer states that in 2004 £8,500 was spent on advertising the CAMPUS range and in 2005 £15,000 was spent.

19) Mr Wintermeyer exhibits copies of articles from various publications at MJW1:

Architecture Today for June 2005 - "Campus is Woodhouse's new co-ordinated wayfinding, lighting and street furniture system. Designed for hospitals, universities and business parks, it includes monolith and wall-mounted signage, plus map points and finger posts. Cycle stands, bollards, bins and seats had the same clear design." A picture of a bench is displayed.

Lighting Design for June/July 2005 - "Woodhouse has developed the campus system for use in universities, as well as hospitals, airports, car parks and business parks. While the range also includes way finding and street furniture elements, it features a selection of luminaires for use in the open as well as on the outside and inside of buildings."

Landscape of June 2005 - "Despite its name, the campus bin is not just for the universities. It's part of an adaptable and street furniture, wayfinding and lighting system from Woodhouse, which could find application in hospitals, airports, car parks, business and science parks as well as its namesake academic environments. The unfussy design and use of sustainable materials is common to the full suite of street furniture: cycle stands, bollards, balustrades, shelters, seats and benches. These products are further complemented by a range of monolith and wall-mounted signage, lectern/map points and finger posts, and a range of new lights. By providing a coordinated series of elements,

Campus aims to "bring a sense of identity, place and clarity to some of our most complex built environments".

External Environment Product Review of July - October 2005 - "Campus is a cost effective, adaptable Wayfinding, Lighting and Street Furniture system from Woodhouse designed for hospitals, universities, airports, car parks, business and science parks. By providing a coordinated series of elements Campus aims to bring a sense of identity, place and clarity to some of our most complex built environments. Throughout the range, materials and manufacturing techniques have been especially selected to ensure at a high level of product quality whilst providing well designed, economical solutions. Campus' design themes and values continue through the full suite of street furniture. Cycle stands, bollards, litterbins, balustrades, shelters, seats and benches all demonstrate the same unfussy co-ordinated design, and feature sustainable materials specially selected to ensure long service life. All street furniture and lighting products are manufactured in a quality assured environment to EN ISO 9001 (2000)."

Lighting Equipment News of August 2005 - "Lighting professionals working with hospitals, universities, airports, car parks, business and science parks might want to take a look at Campus from Woodhouse, a co-ordinated series of lighting devices and street furniture that bring a sense of identity to complex built environments. The principal feature of Campus is the tiny luminaires, which use metal halide lamps. The range includes direct, indirect and catenary-mounted lanterns; wall-mounted uplighters and downlighters, surface-mounted lanterns; illuminated dual cone and indirect bollards. All are sealed to IP66, but the bezel and reflector housings are easy to remove, and access to the gear trays is simple. Campus uses high-frequency electronic ballast control gear as standard, but products can be specified with conventional wire-wound gear."

Mondo Arc for August/September 2005 - an advertisement - "Co-ordinated lighting street furniture wayfinding Campus. Campus is a brand new range of co-ordinated lighting and street furniture from Woodhouse. Affordable and adaptable it is designed to bring a coordinated sense of place to public spaces." The advertisement includes a picture of a bench. An article from the same periodical - "Campus is a cost effective, adaptable system from Woodhouse designed for hospitals, universities, airports, car parks, business and science parks. By providing a coordinated series of elements Campus brings a sense of identity, place and clarity to some of our most complex built environments. Whilst the range also includes Wayfinding and Street Furniture elements, Campus features a full range of newly developed luminaires for use in the open as well as on the outside and inside of buildings. The compact, lightweight fittings have been developed with functional quality and good design as priorities, and show a clear common heritage with other Campus products. Campus Lighting utilises small format ceramic metal-halide (white light) lamp technology to create luminaires of minimal size. The range includes direct, indirect and catenary mounted lanterns, wall mounted uplighters and downlighters, surface mounted lanterns, illuminated dual cone and indirect bollards. Further flexibility comes from a combination of optic and mounting systems allowing for custom lantern arrangements. All the luminaire bodies are sealed to IP66 to give complete protection

from dust and water ingress, however both the bezel and reflector housings on all units are easily removed, and the gear trays also have easy access for simple maintenance."

Lighting Design for October 2005 - "The Campus illuminated Bollard is one element of the coordinated Campus family which includes a comprehensive range of lighting fixtures, street furniture and wayfinding products, designed for hospitals, universities, airports, car parks, business and science parks."

Horticulture Week for 8 December 2005 - "The Campus range from Leamington Spa - based Woodhouse includes co-ordinated litterbins, seating, signage, bollards, cycle stands and shelters, all made from sustainable materials. Woodhouse's Campus products also include lighting for indoors and out, using small-format ceramic metal halide technology." Pictures of a litter bin and lamp are shown.

Riba product card from September 2005 – "CAMPUS is a cost effective, adaptable wayfinding, street furniture and lighting system. Designed for hospitals, universities, airports, parking areas, business and science parks - in fact anywhere where groups of people and mixed activities and services come together - CAMPUS will make your visitors feel informed and safe..." "campus lighting and street furniture from Woodhouse." The product card shows bins, lighting, signage and a bench.

20) Mr Wintermeyer exhibits a definition of "street furniture" from *Collins English Dictionary*: "pieces of equipment, such as street lights and pillar boxes, placed in the street for the benefit of the public". Also exhibited are definitions of "street furniture" from a Google search. Into alia the term is defined as meaning "municipal equipment placed along streets, including light fixtures, fire hydrants, police and fire call boxes, signs, benches and kiosks". Also exhibited from the same sources are definitions of the term "furniture". *Collins English Dictionary* defines inter alia the word as meaning "the movable articles that equip a room, house, etc". The Google definitions add nothing to this.

DECISION

21) To consider the grounds of opposition under both sections 5(1) and 5(2)(a) of the Act, it is necessary to decide what the use shown by Lamhults establishes.

22) Section 6A of the Act reads:

“(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

23) Mr Saunders accepted that Lammhults had shown genuine use of its registered trade mark; where he differed with Mr Brandreth was as to what a fair specification of the goods in relation to which Lammhults trade mark had been used. Mr Brandreth was of the view that a fair description would be *tables and chairs*; Mr Saunders submitted that a fair description would be *moveable tables and chairs for interior use*. There is now a body of case law as to how to arrive at a fair specification of goods in non-use cases:

Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

Animal Trade Mark [2004] FSR 19:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made."

The position established by *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* was recently confirmed in *Mundipharma AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 256/04*, where the Court of First Instance (CFI) stated:

“25 The Court notes that although, in the present case, the applicant has not demonstrated genuine use of the earlier mark for any goods, the fact remains that the intervener has not requested that proof of such use be adduced with respect to ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’. Moreover, as the Board of Appeal observed in paragraph 25 of the contested decision, because under Article 43(2) of Regulation No 40/94 proof of use of the mark on which the opposition is founded need be furnished only when requested by the applicant, it is for the latter to determine the scope of its request for proof. Accordingly, since the intervener’s request for proof did not cover the ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’, it is not necessary to explore whether the earlier mark has been put to genuine use in Germany for those products.

26 Next, it should be borne in mind that the earlier mark was registered for ‘pharmaceutical and sanitary preparations; plasters’. That category of goods is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. Consequently, the fact that the earlier mark must be regarded as having been used for ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’ confers protection only on the sub-category within which those goods fall.

27 In the contested decision, the Board of Appeal held that the earlier mark was to be taken into consideration only in so far as it covered goods the genuine use of which was not contested. It thus defined a sub-category corresponding to those goods, namely ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’.

28 That definition is incompatible with Article 43(2) of Regulation No 40/94, as interpreted in the light of *ALADIN*, and applicable to earlier national marks pursuant to Article 43(3) of that regulation.”

24) It seems to me that Mr Saunders’ submission re a fair specification is more aimed at obtaining as much differentiation between the goods of Marshalls and those of Lammhults as can be managed, rather than arriving at a description that describes the goods fairly; I certainly do not consider that it represents a real/realistic category or sub-category of goods; rather, it represents a pernickety description, the sort which Jacob J in *Animal Trade Mark* said was to be avoided; it seems to me to be dangerously close to the “three-holed razor blades imported from Venezuela” type of description. The inclusion of “for interior use” in the proposed specification raises bizarre potential qualifications. If the chairs supplied to Pizza Express are put outside, is that no longer use of the trade

mark on the goods? The evidence shows that Lammhults produces café tables, are these also not to be placed on patios or courtyards? The specification proposed by Mr Saunders is fundamentally flawed. I consider that Mr Brandreth's proposed specification is a fair description of the goods ie *tables and chairs*.

Section 5(1) of the Act

25) Section 5(1) of the Act reads:

5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

Lammhults' trade mark is an earlier trade mark as defined by the Act.

26) The trade marks are identical.

27) *Tables* of the earlier registration will cover all types of tables in the class and so the *tables* of the application will be identical. Mr Brandreth submitted that *chairs* and *seats* are synonymous. I agree with him. Consequently, *seats* of the application are identical with *chairs* of the earlier registration. *Benches* are long seats; *seats* and *chairs* are synonyms; it would, however, be a classic syllogism to deduce from this that *benches* and *chairs* are the same. I do not consider that they are. I will consider the opposition in relation to *benches* under section 5(2)(a) of the Act.

28) Section 5(1) is solely about questions of fact. If the trade marks are identical and the goods are identical, then a finding under this section of the Act must be made. I, therefore, find that registration of *seats and tables* in the application is to be refused.

Likelihood of confusion – section 5(2)(a) of the Act

29) Section 5(2)(a) of the Act reads:

“(2) A trade mark shall not be registered if because -

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or.....”

30) In determining the question under section 5(2)(a), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P*.

31) The trade marks are identical.

Comparison of goods

32) In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* the ECJ held in relation to the assessment of the similarity of goods that the following factors, inter alia, should be taken into account: their nature, their intended purpose (the original incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected), their method of use and whether they are in competition with each other or are complementary. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

33) *Benches* (being street furniture) and *chairs* can be made of the same materials, they are both for sitting upon. They could both be used outdoors, for the public at large to sit upon; as in the case of deckchairs, and so could be in competition. Deckchairs for a municipality could go through the same channels of trade as *benches* (being street furniture). As Mr Brandreth submitted the external internal divide that Mr Saunders rests much of his case upon is somewhat artificial when one takes into account places such as airports or shopping malls; or indeed one of the purchasers of the products of Lammhults, the Millennium Stadium in Cardiff.

34) I consider that there is a high degree of similarity between *benches* (being street furniture) and *chairs*. (Although nothing turns upon this, I must decided the issue of the basis of the fair specification, it is to be noted the goods that Lammhults supplies under

the trade mark do not appear to be for *domestic or household use*, although they could be. So the exclusion as the end of Marshalls' specification does not assist it.)

Conclusion

35) The case law states that when considering the likelihood of confusion it is necessary to take into account the proximity of the goods, the proximity of the trade marks and the distinctiveness of the earlier trade mark. The trade marks are identical. Lammhults' trade mark neither describes nor alludes to the nature of the goods. I consider that it enjoys a reasonable degree of distinctiveness. I consider that the respective goods under consideration have a high degree of similarity. Mr Saunders argued that there had been no instances of confusion. However, there is no evidence that even one bench, seat or table has been sold. The sales figures given by Marshalls do not identify what actual goods covered by the specification have been sold. It is also the case that the goods marketed under the CAMPUS name by Marshalls are done so with a clear identification to Woodhouse whilst the CAMPUS goods of Lammhults are marketed with a clear identification to Lammhults. It is also necessary to consider the fair specification of Lammhults' goods, not just the specific goods upon which the trade mark has been used. So the absence of confusion tells me nothing. (This matter has been dealt with on several occasions by the courts, see - *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at p 291, *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at p 809 and *Phones 4U Ltd v. Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.) Owing to the identity of the trade marks, however careful the purchasing decision, the purchaser will not be able to distinguish between them; there is nothing to distinguish them by. Taking into account all the relevant factors I find that there is a likelihood of confusion in respect of *benches* (being street furniture).

36) Mr Brandreth's concern re the parts and fittings of the specification related solely to their being parts and fittings of the principal goods. If the principal goods were excised then the objection in relation to parts and fittings becomes otiose. I, therefore, do not need to consider the parts and fittings.

Overall conclusion

37) The application is to be refused in respect of *benches, seats and tables*. The amended specification for class 20 is to read:

Street furniture, namely notice boards, planters, display panels; parts and fittings for all the aforesaid goods; none being for domestic or household use.

(At the hearing Mr Brandreth stated that, if successful, this would satisfy the requirements of Lammhults.)

COSTS

38) Lammhults Möbel AB has been successful and is entitled to a contribution towards its costs. Mr Brandreth submitted that owing to the resistance of Marshalls to Lammhults' case the award should be at the top of the scale. I note that Marshalls were aware that Lammhults would not be happy with a registration of the trade mark in respect of the contested goods, owing to the refusal to grant consent to registration. Lammhults was required to prove use of its trade mark and so had to file evidence in this case. I consider that, taking these factors into account, the award of costs should be at the upper end of the scale; although taking into account the nature of the evidence.

39) I award costs on the following basis:

Opposition fee	£200
Notice of opposition	£300
Considering the counterstatement	£200
Evidence	£750
Considering evidence of the applicant	£375
Preparation and attendance at hearing	£1,500
TOTAL	£3,325

I order Marshalls Mono Limited to pay Lammhults Möbel AB the sum of £3,325. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of April 2007

**David Landau
For the Registrar
the Comptroller-General**